

**REMARKS**

**I. STATUS OF THE CLAIMS**

Claims 167-169, 171, 172, 174, 175, 177, 178, 180-182, and 185-308 are now pending in this application.

**II. OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTIONS**

(A) Claims 167-169, 171, 172, 174, 175, 177, 178, 180-182, and 185-308 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 12-14, 16-23, 28-41, 44-46, 48-55, 60-70, and 72 of copending Application No. 10/022,253. Office Action at 3. Applicants respectfully traverse this rejection.

The claims of copending Application No. 10/022,253 are directed to non-rinse compositions, whereas the claims of the present application are directed to shampoos and conditioners, *i.e.*, rinse compositions. These are express structural limitations on the respective claims. The specification at ¶24 explains that “[t]he term ‘rinse composition’ is used to mean any composition that is formulated to be rinsed off after application to the hair.” Paragraph 25 explains that shampoos and conditioners are examples of rinse compositions. Copending Application No. 10/022,253 similarly explains at ¶16 explains that “[t]he term ‘non-rinse composition’ is used to mean any composition that is formulated so as not to be rinsed off after application to the hair.” The difference is as clear as the structural differences between a shampoo (rinse) and a hair spray (non-rinse). Accordingly,

one of ordinary skill in the art would recognize that the two sets of claims require the application of different sets of formulation technology to make a composition either as a shampoo/conditioner composition or as a non-rinse composition. Moreover, there is nothing of record that establishes either a shampoo or conditioner as being obvious in view of a non-rinse composition.

For these reasons, Applicants submit that the rejection is inappropriate and should be withdrawn.

(B) Claims 167-169, 171, 172, 174, 175, 177, 178, 180-182, and 185-308 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, 13-17, and 19-21 of copending Application No. 09/627,055.

While Applicants disagree with the merits of the rejection, in order to advance the prosecution of this application, Applicants have filed concurrently herewith a Terminal Disclaimer over copending Application No. 09/627,055. Accordingly, Applicants respectfully submit that this ground for rejection should be withdrawn as moot.

### **III. REJECTIONS UNDER 35 U.S.C. § 103(a)**

(A) The Examiner has rejected claims 167-169, 180-182, 185-208, and 284-307 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,013,722 (*Yang et al.*) for the reasons disclosed at pages 4-6 of the Office Action. Applicants respectfully traverse this rejection for at least the reasons set forth below. Specifically, the Examiner has not and cannot establish, *inter alia*, that (1) *Yang et*

*al.* teaches or suggests all of the claim limitations. or (2) a motivation exists to achieve the recited claim limitations. See M.P.E.P. §§ 2143.01 and 2143.03

**A. YANG ET AL. FAILS TO TEACH OR SUGGEST  
ALL OF THE CLAIM LIMITATIONS**

**1. YANG ET AL. FAILS TO TEACH OR SUGGEST  
“A HAIR STYLING” COMPOSITION.**

Applicants submit that the preamble of claims 167-169, 180-182, 185-208, and 284-307 is a limitation upon the scope of the claims, which distinguishes the claims over *Yang et al.* The Examiner has argued that “the recitation ‘reshapable hair styling’ has not been given patentable weight because the recitation occurs in the preamble.” Office Action at 5. Applicants respectfully traverse for at least the following three independent reasons:

- (1) a preamble is limitation when one could not identify the scope of the claims without it,
- (2) a preamble is limitations when it is intertwined with the body of the claims, and
- (3) a preamble is limitations when applicants’ specification suggests that the invention is so limited.

Each independently justifies a determination that “reshapable hair styling composition” is a limitation on all claims.

First, as stated in the M.P.E.P., “a preamble has the import that the claim as a whole suggests for it.” M.P.E.P. § 2111.02. Here, the identification of (1) a specific class of (meth)acrylic polymers and (2) a surfactant in the body of each rejected

claim cannot alone define Applicants' invention. See *Rowe v. Dror*, 42 U.S.P.Q.2d 1550, 1553 (Fed. Cir. 1997). Without the preamble, one could not identify the scope of the claims. For example, a polymer in combination with a surfactant may be found in any number of cosmetic compositions which are not hairstyling compositions. Polymers may serve many uses other than as a hair fixative, such as a viscosity modifier, a lubricant, an encapsulating material, etc. Hence, without the preamble, one of ordinary skill in the art would not know the structure of the compositions of the claims.

Second, the Courts have held that one should consider whether the preamble is intertwined with the body of the claim. For example, in *Gerber Garment Technology Inc. v. Lectra Systems Inc.*, 16 U.S.P.Q.2d 1436 (Fed. Cir. 1990), the Court held the preamble, "a tool in the form of a cutting blade," was a limitation upon the claims because of the later referral to "cutting blade" in the body of the claim. *Id.* at 1441; see also, *Rohm and Haas Co. v. Brotech Corp.*, 44 U.S.P.Q.2d 1459, 1461 n.1 (Fed. Cir. 1997). Here the preamble of the rejected claims recites "a reshapable hair styling composition" and the body recites both "a reshapable effect," which is defined by the specification as a particular effect achieved with hair, and "shampoo," which is a specific type of hair styling compositions. Because of the repetition of language in the body, the preamble is integral to Applicants' claims and is a limitation. See 16 U.S. P.Q.2d at 1441.

Third, whether or not the preamble is a structural limitation "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." M.P.E.P. §

2111.02; *see also*, *Corning Glass Works v. Sumitomo Electric U.S.A. Inc.*, 9 U.S.P.Q.2d 1962, 1966 (Fed. Cir. 1989). Here, Applicants' specification makes it abundantly clear that Applicants did not invent all compositions that comprise the recited polymers, rather only those compositions which are (1) hair styling compositions with (2) a reshapable effect and are also, with respect to the rejected claims, shampoos. In every instance, the invention is described in the specification in terms of it being a hair styling composition. Even in the first paragraph, the specification explains that "the present invention relates to a reshapable hair styling composition that is a rinse composition." Paraphrasing the Federal Circuit in *Corning Glass Works*, "to read the claim in light of the specification indiscriminately to cover all types of [compositions] would be divorced from reality. The invention is restricted to those [compositions] that work as [hair styling compositions] as defined in the specification, which is not true with respect to [compositions] constructed with the limitations of [the recited polymer and surfactant] only." 9 U.S.P.Q.2d at 1966.

Finally, Applicants submit that its claims are like those of Robie in *Kropa v. Robie*, 88 U.S.P.Q. 478 (C.C.P.A. 1951). In *Kropa*, the Court held that the claim's preamble, "an abrasive article," was essential to define the scope of the claims that recited "abrasive grains and a hardened binder." *Id.* at 481. To paraphrase the Court, not every union of an acrylic polymer and cosmetic vehicle is a "reshapable hair styling composition," let alone a "hair styling composition." *See id.*

The phrase, a reshapable hair styling composition, is a limitation that is "necessary to give life, meaning, and vitality" to Applicants' claims and which *Yang et al.* does not explicitly or inherently teach. Rather, *Yang et al.* merely teaches a

pressure sensitive adhesive suitable only for labels, decals, and the like. Col. 2, lines 20-32, col. 7, lines 16-20.

**2. YANG ET AL. FAILS TO TEACH OR SUGGEST  
"AT LEAST ONE SURFACTANT".**

Applicants submit that the Office has failed to establish whether *Yang et al.* expressly or inherently discloses "at least one surfactant," as required by claims 167-169, 180-182, 185-208, and 284-307. The Office has merely argued that *Yang et al.* teaches that surfactants "as additional ingredients." Office Action at 4.

Applicants respectfully disagree with the Office's interpretation of *Yang et al.*'s teachings. *Yang et al.* does not teach the inclusion of at least one surfactant with at least one (meth)acrylic polymer to form a composition, let alone a hair styling composition, as required by Applicants' claims. Rather, *Yang et al.* only teaches the use of surfactants in the emulsion polymerization process from which the (meth)acrylic polymer is a product. Col. 4, line 65 - col. 6, line 26. Specifically, Yang et al. teaches the combination of various monomers and other reactants with a possible surfactant, which are then reacted to form the polymer. Col. 5, line 56- col. 6, line 26. In fact, according to *Yang et al.*, the (meth)acrylic polymer must be separated from the resultant emulsion, which would retain any unreacted surfactant.<sup>1</sup> Col. 6, lines 16-18, and Examples. This is a distinction that even *Engel*

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<sup>1</sup> To the extent that the Examiner is arguing that the intermediate emulsion polymerization product, which comprises the polymer and possibly unreacted surfactant, is Applicants' composition, Applicants direct the Examiner to M.P.E.P. 2144.09, discussing *In re Lalu*, 223 U.S.P.Q. 1257, 1260 (Fed. Cir. 1984), which dictates that obviousness cannot be based on such intermediate products.

*et al.* (cited by the Examiner and discussed below) recognizes. *Engel* at ¶¶40-41.

Thus, *Yang et al.* teaches that the useful product, *i.e.*, the polymer, must be separated from any unreacted surfactant.

Since *Yang et al.* merely discloses the use of surfactants in the manufacture of a single component and not for use as an independent component in a composition, *Yang et al.* does not render Applicants' rejected claims as obvious.

**3. YANG ET AL. FAILS TO TEACH OR SUGGEST THE COMBINATION OF N-BUTYL ACRYLATE, 2-HYDROXY ETHYL (METH)ACRYLATE, AND 2-ETHYL HEXYL ACRYLATE MONOMERS.**

Applicants submit that *Yang et al.* fails to teach the weight percent limitations of independent claims 180 and 181 and all of the claims that depend therefrom.

Specifically, claims 180 and 181 recite:

- (a) from about 30 to about 40 weight percent of units derived from at least one monomer chosen from n-butyl acrylate monomers,
- (b) from about 2 to about 10 weight percent of units derived from at least one monomer chosen from 2-hydroxy ethyl methacrylate monomers, and
- (c) from about 50 to about 70 weight percent of units derived from at least one monomer chosen from 2-ethyl hexyl acrylate monomers

In contrast, *Yang et al.* discloses the use of 50-90%, preferably 70-90% by weight n-butyl acrylate. Col. 3, lines 14-15. Similarly, *Yang et al.* discloses the use of 10-50% by weight 2-hydroxy ethyl methacrylate and optionally 0-50% by weight alkylacrylate monomers, which may include 2-ethyl hexyl acrylate. Col. 3, lines 15-34.

The Examiner has asserted that it would have been obvious to a person of ordinary skill in the art to modify the weight percentages. Office Action at 5. Applicants disagree. Nothing in *Yang et al.* suggests that its ranges can be modified from those disclosed. Further nothing in *Yang et al.* associates modifying these weight percentages, such as of n-butyl acrylate, with any particular property. The M.P.E.P. explains that the Examiner's analysis applying *In re Aller* is inapplicable under these facts, because there is no basis to impute such knowledge upon a person of ordinary skill in the art. See M.P.E.P. § 2144.05(II)(B).

Accordingly, at least claims 180-182 and 284-307 are not obvious in view of over *Yang et al.*

**4. YANG ET AL. FAILS TO TEACH OR  
SUGGEST A "RESHAPABLE EFFECT."**

Applicants submit that the reshapable effect limitation upon the claimed composition further distinguishes the claims over *Yang et al.* Here, the Examiner has asserted that "reshapable effect" is merely a use that can be ignored. Office Action at 5-6. Applicants submit that the Examiner is factually and legally incorrect.

First, all of the rejected claims are composition claims. Accordingly, the Examiner's reliance upon *In re Otto* and *In re Casey* is misplaced, since those decisions are limited to method claims.

Second, it is well established that composition claims are not limited to recitations of physical structures. Functional limitations are a legitimate form of defining the patentable scope of the claims. M.P.E.P. § 2173.05(g). Where the claim recites an intended use or property that is distinguishable over the prior art, an



obviousness rejection may not be appropriate. See *In re Pearson*, 181 U.S.P.Q. 641, 644 (C.C.P.A. 1974). This has been particularly true in the art where polymers are concerned. *E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 7 U.S.P.Q.2d 1129, 1133 (Fed. Cir. 1988) (“[o]n occasion, particularly with polymers, structure alone may be inadequate to define the invention, making it appropriate to define the invention in part by property limitations.”). Accordingly, the Examiner’s argument that “a recitation of intended use of the claimed invention must result in a structural difference. . . to patentably distinguish the claimed invention from the prior art” (Office Action at 5) is contrary to U.S. patent law with respect to compositions. Compare M.P.E.P. § 2114 (regarding apparatuses).

The Examiner has also stated that “[i]f the prior art structure is capable of performing the intended use, then it meets the claim.” Office Action at 5. To the extent this is an inherency argument, it is improper because the Examiner has not established that there is any basis to believe that so-called compositions of Yang et al. have a reshapable effect. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (conclusory assertions cannot be the basis for a *prima facie* obviousness rejection). In particular, the Examiner has not established that the pressure-sensitive adhesives of *Yang et al.* are identical to Applicants’ compositions. See M.P.E.P. § 2112.01 (requiring identical (not similar) composition)

It is the Examiner’s burden to provide factual and technical grounds establishing that the claimed feature necessarily flows from the teachings of the prior art. See *Ex Parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990). The Office must cite facts in support of a Section 103 rejection and not the Office’s

opinion. *In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) (“With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or expertise . . . Rather, the Board must point to some concrete evidence in the record in support of these findings.”).

The law is specific regarding the degree of details needed in the rejection with respect to inherency. *Ex parte Schricker*, 56 U.S.P.Q.2d 1723, 1725 (Bd. Pat. App. & Int. 2000) (“[W]hen an examiner relies on inherency, it is incumbent on the examiner to point to the ‘page and line’ of the prior art which justifies an inherency theory.”) (emphasis in original). According to the M.P.E.P., “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” M.P.E.P. § 2112 (emphasis added).

Moreover, it is well established that the mere disclosure of a polymer family (and methods of manufacture) is not always a disclosure of a polymer with a given property. For example, U.S. Patent No. 4,994,088 at Table 2 discloses that the solubility of known dimethyl aminoethyl methacrylate/ 2-acrylamido-2-methylpropanesulfonic acid polymers varies as a function of monomer ratio. Similarly, U.S. Patent No. 6,194,363 at col. 6, lines 38-46 explains that the cationic charge density of known cationic deposition polymers is also a function of monomer ratios. This is in keeping with the understanding of the federal courts that “[o]n occasion, particularly with polymers, structure alone may be inadequate to define the invention, making it appropriate to define the invention in part by property

limitations." *E.I. Du Pont*, 7 U.S.P.Q.2d at 1133. Accordingly, without more information, there can be no basis in fact to say that the *Yang et al.*'s disclosure of a product family or method of manufacture is also a disclosure of a composition with a reshapable effect.

This is true even if there is a disclosure of a family of compounds, some of whose members meet that functional limitation. For example, in *Akzo N.V. v. U.S. Int'l Trade Comm.*, the Federal Circuit affirmed a finding of no inherency from the mere disclosure of a process of manufacturing a compound. 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). The claim-at-issue recited a method of manufacturing aramid fibers using 98% concentrated sulfuric acid. *Id.* The cited reference taught each element of the claim, including the use of sulfuric acid; however, the reference did not expressly teach the use of 98% concentrated sulfuric acid. *Id.* The Federal Circuit affirmed the Commission's finding "that concentrated sulfuric acid is not inherently 98% sulfuric acid to one skilled in the art." *Id.* (emphasis in original). Even though the term "sulfuric acid" encompasses "98% concentrated sulfuric acid," that is only a mere probability and not an inherent disclosure.

*Yang et al.* fails for the same reasons that the cited reference in *Akzo* failed. At best, it is only a mere possibility that one of ordinary skill in the art looking at *Yang et al.* would select at least one (meth)acrylic polymer, as claimed, and then attempt to use it in a manner such that a composition is formed that provides a reshapable effect, as required by all pending claims.

Accordingly, since there is neither factual nor legal support to conclude that *Yang et al.* teaches or suggests each and every limitation of the present claims, as

required for a *prima facie* case of obviousness, the rejection under Section 103(a) should be withdrawn. See, M.P.E.P. § 2143

**B. THERE IS NO MOTIVATION IN YANG ET AL. OR THE PRIOR ART  
TO DUPLICATE THE CLAIMS' SELECTION OF MONOMERS**

Applicants admit that the presently claimed monomers are individually disclosed in *Yang et al.*, which is all the Examiner has suggested (Office Action at 4); however, they are never in the same composition. The mere disclosure of each and every element in a single reference is not enough to establish obviousness; there must be motivation to combine those elements found in the prior art in the manner presented in the claims, otherwise the rejection is improper. M.P.E.P. § 2143.02, *discussing, In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Applicants submit that the Examiner is improperly ***picking, choosing, and combining various disclosures*** within *Yang et al.* *In re Luvisi*, 144 U.S.P.Q. 646, 649-50 (C.C.P.A. 1965). *Yang et al.* merely discloses the possible use of 2-ethyl hexyl acrylate among a list of nineteen optional monomers. See col. 2, lines 33-51. And yet, not a single example suggests the superiority of 2-ethyl hexyl acrylate over the other possible optional monomers. *In re Baird*, 28 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 1994) ("A disclosure of millions of compounds does not render obvious a claim to [a subgenus], particularly when that disclosure indicates a preference leading away from the claimed compounds).

The motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. See, e.g., *In re Napier*, 34 U.S.P.Q.2d 1782, 1784 (Fed.

Cir. 1995). In order to support a rejection under 35 U.S.C. § 103, therefore, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). However, *Yang et al.* does not provide the necessary selection rules to allow a person of ordinary skill in the art to reach Applicants' claimed invention.

In view of *Yang et al.*'s deficiencies detailed above, claims 167-169, 180-182, 185-208, and 284-307 are not rendered obvious. Applicants respectfully request withdrawal of this rejection.

(B) The Examiner has rejected claims 167-169, 171, 172, 174, 175, 177, 178, 180-182, and 185-308 under 35 U.S.C. § 103(a) as obvious over U.S. Patent Application No. 2002/0058754 (*Engel et al.*) in view of *Yang et al.* for the reasons disclosed at pages 6-8 of the Office Action. Applicants respectfully traverse this rejection for at least the reasons set forth below.

Specifically, the Examiner has not and cannot establish, *inter alia*, that (1) the combination of *Engel et al.* and *Yang et al.* teach or suggest all of the claim limitations, or (2) a motivation exists to achieve the recited claim limitations. See M.P.E.P. §§ 2143.01 and 2143.03.

**A. THE REFERENCES FAIL TO TEACH OR SUGGEST  
ALL OF THE CLAIM LIMITATIONS**

**1. BOTH REFERENCES FAIL TO TEACH OR SUGGEST  
“A HAIR STYLING” COMPOSITION.**

Applicants submit that the preamble of claims 167-169, 171, 172, 174, 175, 177, 178, 180-182, and 185-308 is a limitation upon the scope of the claims, which distinguishes the claims over the prior art for the very same reasons provided above and incorporated herein in full.

As discussed above, *Yang et al.* merely teaches a pressure sensitive adhesive suitable only for labels, decals, and the like. Col. 2, lines 20-32, col. 7, lines 16-20. Similarly, *Engel et al.* merely discloses pressure sensitive adhesive suitable only for skin. ¶¶10; 18. Neither reference teaches or suggests a hair styling composition.

**2. BOTH REFERENCES FAIL TO TEACH OR SUGGEST  
“AT LEAST ONE CONDITIONER”.**

Applicants submit that the Examiner has failed to establish whether either *Engel et al.* or *Yang et al.* expressly or inherently discloses “at least one conditioning agent,” as required by claims 171, 172, 174, 175, 177, 178, and 210-283.

As defined in Applicants’ specification, “the term ‘conditioning agent’ means any agent whose function is to improve the cosmetic properties of the hair, for example, the softness, ease of disentangling, feel, and lack of static electricity.” Specification at ¶50. Neither *Engel et al.* nor *Yang et al.* discloses such a

conditioning agent. This is not surprising in view of the fact that neither reference is directed to hair styling compositions.

**3. BOTH REFERENCES FAIL TO TEACH OR SUGGEST THE COMBINATION OF N-BUTYL ACRYLATE, 2-HYDROXY ETHYL (METH)ACRYLATE, AND 2-ETHYL HEXYL ACRYLATE MONOMERS.**

Applicants submit that neither *Engel et al.* nor *Yang et al.* teaches the weight percent limitations of independent claims 177, 178, 180 and 181 and all of the claims that depend therefrom. For the very same reasons discussed above with respect to claims 180 and 181, *Yang et al.* does not teach or suggest Applicants' weight percent limitations. Also as discussed above, *Yang et al.* does not recognize the correlation between weight percent and any property that would permit the Examiner's application of *In re Aller*. See M.P.E.P. § 2144.05(II)(B). Further, *Engel et al.* does not correct this deficiency, in view of the fact that *Engel et al.*'s only explicit direction for weight percentages is that vinyl monomers comprise at least 80 parts, based on 100 parts total monomer content. ¶133.

**4. BOTH REFERENCES FAIL TO TEACH OR SUGGEST A "RESHAPABLE EFFECT."**

Applicants submit that the reshapable effect limitation upon the claimed composition further distinguishes the claims over the combination of *Engel et al.* and *Yang et al.* As above, the Examiner has asserted that "reshapable effect" is merely a use that can be ignored. Office Action at 7-8. Applicants submit that the Examiner is factually and legally incorrect.

First, all of the rejected claims are composition claims, such that the Examiner's citation to *In re Otto* and *In re Casey* has no bearing on obviousness.

Second, as discussed in detail above, it is well established that composition claims are not limited to recitations of physical structures. *E.I. Du Pont*, 7 U.S.P.Q.2d at 1133 (“[o]n occasion, particularly with polymers, structure alone may be inadequate to define the invention, making it appropriate to define the invention in part by property limitations.”). Accordingly, the Examiner's argument that “a recitation of intended use of the claimed invention must result in a structural difference. . . to patentably distinguish the claimed invention from the prior art” (Office Action at 7) is contrary to U.S. patent law with respect to compositions.

The Examiner has also stated that “If the prior art structure is capable of performing the intended use, then it meets the claim.” Office Action at 7. To the extent this is an inherency argument, it is improper because the Examiner has not established that there is any basis to believe that skin composition of *Engel et al.* comprising the polymer of *Yang et al.* would have a reshapable effect.

As discussed above, it is the Examiner's burden to provide factual and technical grounds establishing that the claimed feature necessarily flows from the teachings of the prior art. See *Ex Parte Levy*, 17 U.S.P.Q.2d at 1464. The Examiner has cited no facts that would support the conclusion that the use of *Yang et al.*'s adhesive in *Engel et al.*'s skin composition would result in a composition with a reshapable effect. *Ex parte Schricker*, 56 U.S.P.Q.2d at 1725 (“[W]hen an examiner relies on inherency, it is incumbent on the examiner to point to the ‘page and line’ of the prior art which justifies an inherency theory.”) (emphasis in original). It is hard to



imagine that a person of ordinary skill would believe so, given that *Engel et al.*'s compositions are not hair styling compositions.

Accordingly, since there is neither factual nor legal support to conclude that *Engel et al.* in combination with *Yang et al.* teaches or suggests each and every limitation of the present claims, as required for a *prima facie* case of obviousness, the rejection under Section 103(a) should be withdrawn. See M.P.E.P. § 2143.

**B. THERE IS NO MOTIVATION IN THE REFERENCES  
TO DUPLICATE THE CLAIMS' SELECTION OF MONOMERS**

As discussed above, Applicants admit that the presently claimed monomers are individually disclosed in *Yang et al.*, which is all the Examiner has suggested (Office Action at 7); however, they are never in the same composition. The mere disclosure of each and every element in a single reference is not enough to establish obviousness; there must be motivation to combine those elements found in the prior art in the manner presented in the claims, otherwise the rejection is improper. M.P.E.P. § 2143.02, discussing, *In re Rouffet*, 47 U.S.P.Q.2d at 1458. Similarly, *Engel et al.* does not provide any selection rules for selecting the monomers required by the claims. Accordingly, there is no basis for a person of ordinary skill in the art to combine the references and obtain Applicants' claimed invention.

**C. THERE IS NO MOTIVATION IN TO USE YANG ET AL.'S  
POLYMERS IN ENGEL ET AL.'S SKIN COMPOSITIONS**

In order to establish a *prima facie* case of obviousness, the Examiner must show that there was some motivation in the art for a person of ordinary skill in the art to combine *Yang et al.*'s polymers with *Engel et al.*'s skin compositions. See,

M.P.E.P. § 2143.01. The Examiner has asserted that it would have been obvious to substitute one pressure sensitive adhesive for another pressure sensitive adhesive. Office Action at 7. Applicants respectfully disagree.

The M.P.E.P. has explained that “the mere fact that references can be combined . . . does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01. While the Examiner has suggested that water resistance and low haze of *Yang et al.*’s polymer is a motivation (Office Action at 7), the Examiner has not shown that there is a respective need in *Engel et al.* In fact, there is not. *Engel et al.* already teaches that its composition comprises hydrophobic coating, so there is no need for *Yang et al.*’s water resistance polymer. ¶¶55-58. Moreover, *Engel et al.* explains that it is desirable to have a nearly white adhesive and not a clear adhesive. ¶51. Hence, *Engel et al.* teaches away from the proposed combination for the very reason the Examiner has asserted is a motivation to combine.

In view of *Engel et al.*’s and *Yang et al.*’s deficiencies detailed above, claims 167-169, 171, 172, 174, 175, 177, 178, 180-182, and 185-308 are not rendered obvious. Applicants respectfully request withdrawal of this rejection.

#### IV. CONCLUSION

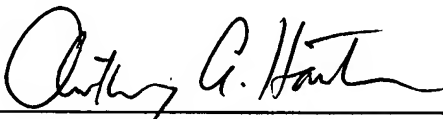
In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and  
charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: March 10, 2004

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